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EXAMINER

LEE, DIANE I

ART UNIT PAPER NUMBER

2876

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/762,684

Applicant(s)

WURZBURG, HENRY

Examiner

D. I. Lee

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-16 and 18 is/are rejected.
- 7) ☒ Claim(s) 10 and 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/04, 1/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

1. Claims 1-18 are presented for examination

### *Claim Objections*

2. Claim 5 is objected to because of the following informalities:

(a) Re claim 5, line 2: ".SmartMedia" should be changed to -- SmartMedia --.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. **Claims 1-2, 7-8, and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Bilich et al. [US 5,877,483-referred as Bilich].**

**Re Claim 1:** Bilich discloses a system, comprising:

a processor (CPU 14);

a host controller (logic 22) coupled to the processor (CPU 14);

a card reader 16 coupled to the host controller 22 via bus 18; and

wherein the card reader 16 does not apply power to a memory card 20 inserted into the card reader 16 if the memory card 20 has not been accessed in a first specified amount of time (i.e., Figure 1 shows the PC 10 comprising a power supply 12 connected to the CPU 14, memory 15, the card reader 16, and various I/O devices 17 for providing power thereto via one or more buses, the card is inserted to the reader to identify the authorized user, and when there

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has been no I/O activity of the predetermined time period, the PC 10 is powered down, see the abstract, col. 2, lines 15-24; col. 3, line 8-col. 4, line 37; and figures 1-2).

**Re Claim 2:** wherein the card reader is internal to a computer system (i.e., PC 10) housing the processor (CPU 14, see figure 1).

**Re Claim 7:** if the memory card is accessed, power is applied to the memory card (see col. 3, lines 62+).

**Re Claim 8:** wherein the card reader is electrically disconnected from the host controller if the card has not been accessed for a second specified amount of time (see step 215 of figure 2).

**Re Claim 11:** wherein the host controller provides a peripheral bus interface for the card reader (see figure 1).

**Re Claims 12 and 15-16:** Bilich discloses applying power to a memory card in a card reader coupled to a computer (i.e., applying an electromagnetic field power to a memory card 20, which is in a form of magnetic stripe or bar code, in a card reader when the card is inserted into the reader);

detecting whether a memory card has been accessed during a first specified amount of time (i.e., detecting any I/O activity, which also includes activity of access the data from the card, see the abstract, col. 2, lines 15-24; col. 3, line 8-col. 4, line 37; and figures 1-2);

if a memory card has not been accessed during a first specified amount of time, removing power from the memory card (i.e., when there has been no I/O activity of the predetermined time period, the PC 10 is powered down, thus, no electrical power is supplied to the card reader, which inherently includes the step of removing the electromagnetic field power applied to the memory card, see the abstract, col. 3, line 8-col. 4, line 37; and figures 1-2); and

if a memory card has been accessed during a first specified amount of time, continuing to power the memory card (see step 212 of figure 2).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 6, 9, 14, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bilich.** The teachings of Bilich have been discussed above.

Although Bilich teaches that the specified amount of time is five minutes, Bilich does not explicitly states the first specified amount of time is approximately 0 to 10 seconds and second specified amount of time is approximately 0 to 10 minutes.

However, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to adjust the duration setting of the specified amount of time according to the availability of the power source capacity in the system, thus, setting the duration of the specified amount of time to greater or less than 5 minutes would have been obvious extension taught by Bilich.

7. **Claims 3-5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bilich in view of Admitted Prior Art by the Applicant [APAA].** The teachings of Bilich have been discussed above.

Bilich does not disclose that the memory card is a flash memory card and the card reader is external to a computer system housing the processor.

APAA discloses that in the field of computer systems, the memory card is a flash memory card and the majority of flash-memory cards currently on the market are typically one of a smartMedia™ (SM) memory card, xD Picture Cards™ (xD), a Memory Stick™, a High Speed Memory Stick (HSMS), a Memory Stick PRO™ (MSPRO), a Secure Digital (SD) memory card, a MultiMediaMemory™ memory card (MMC), NAND Flash, Compact Flash™ (CF) or a CF form-factor Advanced Technology Attachment (ATA) hard drive (see page 2, lines 4-13). Further, the card reader is external to a computer system housing the processor, i.e., PDA and other handheld device using flash-memory card is typically an external device to a computer system housing the processor (see page 2, lines 10+).

### ***Double Patenting***

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. **Claims 1-4, 6-16, and 18 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-59 of copending Application No. 10/762,767.** Although the conflicting claims are not identical, they are not patentably distinct from each other because for example, all recited limitations in claims

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1-4, 6-16, and 18 of the instant application are inherently and/or obviously found in claims 1-59 of the copending Application No. 10/762,767, as evidence shown below:

Re claims 1 and 4, A system, comprising: a processor, a host controller coupled to the processor, a card reader (i.e., a device) coupled to the host controller; and wherein the card reader (the device) does not apply power to a memory card inserted into the card reader (the device is electrically disconnected from the host controller) if the memory card has not been accessed in a first specified amount of time (i.e., if the device is not in an active state, wherein the device is a card reader and the active state comprises a memory card inserted in the reader and) (see claims 1-2, 7, 15, 29, and 47-48 of copending Application No. 10/762,767), and wherein the memory card obviously include a flash type memory card.

Re claims 2-3: wherein the card reader is internal and/or to a computer system housing the processor (i.e., the device comprises keyboard, a mouse, a speaker, a microphone, a printer, a camera, a scanner, a touchscreen, a card reader) (see claims 42 of the copending Application No. 10/762,767).

Re claim 6-9: wherein the first specified amount of time is approximately 0 to 10 seconds.

Although copending Application No. 10/762,767 teaches that if the device is not in active state, the device is electrically disconnected after a wait period, but does not explicitly states the first wait period is approximately 0 to 10 seconds and second wait period is approximately 0 to 10 minutes.

However, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to adjust the duration setting of the specified amount of time according to the capacity of the power source in the system, thus, setting the wait period to be greater or

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less than 5 minutes would have been obvious modification of the system which may depend on the type of the power source is used.

Re claim 10: wherein a sideband signal is used to signal the card reader (the device) to electrically reconnect to the host controller if there is an attempt to access the card (see claim 10 of the copending Application No. 10/762,767)

Re claim 11: wherein the host controller provides a peripheral bus interface for the card reader (see claim 11 of the copending Application No. 10/762,767).

Thus, in respect to above discussion, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to use the teachings of claims 1-59 of the copending Application No. 10/762,767 as a general teachings for a card reading system as claimed by the present application. The instant claims obviously encompass the claimed invention of the copending Application No. 10/762,767 and differ only in terminology and/or broader in scope.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Allowable Subject Matter***

10. Claims 10 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. The following is a statement of reasons for the indication of allowable subject matter: the best prior art of the record fails to teach or fairly suggest the system using a sideband signal to signal the card reader to electrically reconnect to the host controller if there is an attempt to access the card, as set forth in the claims.



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12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Shoda [JP 08-050643] discloses a system with a low power consumption mode when the card is not accessed by the computer in predetermined period; and

Ishii et al. [US 5,541,985] discloses an IC card reader with the CPU controlling the power supplied to the card based on the access activity necessary to the card.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. I. Lee whose telephone number is (571) 272-2399. The examiner can normally be reached on Monday through Thursday from 5:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



D. I. Lee  
Primary Examiner  
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